Durbin et al.   S/N: 09/683,561

REMARKS

Entry of the above-noted amendments, reconsideration of the application, and allowance of all claims pending are respectfully requested. By this amendment, claims 1, 10, 17, 22, and 24 are amended and claims 27-29 are added. These amendments to the claims constitute a bona fide attempt by Applicants to advance prosecution of the application and obtain allowance of certain claims, and are in no way meant to acquiesce to the substance of the rejections. Support for the amendments can be found throughout the specification (e.g., paragraphs 19, 26, 29, and 33), figures (FIGS. 1-3), and claims and thus, no new matter has been added. Claims 1-29 are pending.

Interview on November 2, 2005:

The amendments herein follow a telephone conference between the Examiner and Applicants' attorney on November 2, 2005 as indicated in the Interview Summary with the addition that positive discussion was had, including positive discussion that the amendment presented herewith in claim 24 of deleting "sufficient" and replacing with "a" would tend to overcome the rejection under 35 U.S.C. §112, second paragraph, of claims 24-26.

The time and courtesy afforded Applicants' attorney as well as the positive discussion had, are gratefully acknowledged by Applicants.

Claim Rejections - 35 U.S.C. § 101

Claims 17-21 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. This rejection is respectfully, but most strenuously, traversed.

The Office Action states: "The claims are directed to a computer data signal, not tangibly embodied." The Interview Summary states: "The 101 rejection and 112 rejection was discussed. The Examiner suggested that as the claims stand, the 101 and 112 rejections would be maintained. Particularly, the 101 rejection would be maintained in light of the current guidelines posted 10/26/05 regarding examining claims for statutory classification."

Without acquiescing in the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Applicants wish to note the following language on pages 55 and 57:

7

(c) Electro-Magnetic Signals

Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.

...

...A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101.

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

These interim guidelines propose that such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of § 101. Public comment is sought for further evaluation of this question.

Besides the indefiniteness of the Interim Guidelines, it is instructive to note the language:

On the other hand, from a technological standpoint, a signal encoded with functional descriptive material is similar to a computer-readable memory encoded with functional descriptive material, in that they both create a functional interrelationship with a computer. In other words, a computer is able to execute the encoded functions, regardless of whether the format is a disk or a signal.

Claim 17 recites, *inter alia*:

A computer data signal embodied in a carrier wave and representing a sequence of instructions which, when executed by at least one processor, causes the at least one processor to:

Plainly, the limitations recited in Applicants' independent claim 17 "create a functional interrelationship with a computer". Plainly, the limitations recited in Applicants' independent claim 17 recite more than "physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*."

It is generally recognized that "anything under the sun that is made by man" may be patentable with three notable exceptions: abstract ideas, laws of nature, and natural phenomena. See MPEP §2106.IV.A. "These three exclusions recognize that subject matter that is not a practical application or use of an idea, a law of nature or a natural phenomenon is not patentable." Id. In short, a claim directed to the practical use of natural phenomenon is patentable, but the natural phenomenon itself is not.

8

Durbin et al.   S/N: 09/683,561

The Office Action has not shown any naturally occurring instance of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to execute as recited in Applicants' independent claim 17.

Where natural phenomena, such as electricity and magnetism are claimed, the courts have held that a signal claim directed to a practical application is statutory regardless of its transitory nature. See MPEP §2106.IV.B.1(c) citing O'Reilly v. Morse 56 U.S. (15 How) 62, 114-19 and In re Breslow, 616 F.2d 516, 519-21, 205 USPQ 221, 225-26 (CCPA 1980). As stated in MPEP §2106.IV.B.1, in the final analysis under §101 the claimed invention, as a whole, must be evaluated for what it is. See In re Abele 684 F.2d 902, 907, 214 USPQ 682, 687. Applicants' independent claim 17 does not call for an abstract idea, a physical phenomenon, or a law of nature. When independent claim 17 is viewed as a whole, it is clear that Applicants recite the practical application of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to execute as claimed.

Withdrawal of the § 101 rejections is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 112

Claims 24-26 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The Office action stated: "The limitation 'sufficient time' is indefinite." Applicants have amended claim 24 to delete "sufficient" and replace with "a", as discussed in the Interview.

Withdrawal of the § 112, second paragraph, rejection is therefore respectfully requested.

Claim Rejections - 35 U.S.C. §§ 102 and 103:

Claims 17, 19, 22, and 24 are rejected under 35 U.S.C. §102 (e) as being anticipated by Steinmetz et al. (USP 6,672,505; "Steinmetz"). Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz, as applied to claim 17 above, in further view of Silver et al. (US Pub. 2002/0023136; "Silver"). Claims 20 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz, as applied to claim 17 above, in further view of Fenstemaker et al. (USP 6,490,684; "Fenstemaker"). Claims 1-5, 7-12, 16-17, and 20-21 are rejected under 35

9

Durbin et al.   S/N: 09/683,561

U.S.C. §103(a) as being unpatentable over Rive (USP 6,301,666) in view of Fenstemaker. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rive and Fenstemaker, as applied to claim 12 above, in further view of Mccown et al. (US Pub. 2002/0124168; "Mccown"). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rive and Fenstemaker, as applied to claim 10 above, in further view of Steinmetz. Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Rive and Fenstemaker, as applied to claim 17 above, in further view of Silver. Claims 23 and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz. Claims 6 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rive and Fenstemaker, as applied to claims 1 and 10 above, in further of "Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch our for the strings" by Castagna. Claim 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over Steinmetz, as applied to claim 24 above, in view of Castagna, and Dutta (US Pub. 2002/0078177). These rejections are respectfully, but most strenuously, traversed.

It is well-settled that there is no anticipation unless (1) all the same elements are (2) found in exactly the same situation and (3) are united in the same way to (4) perform the identical function. Since the Office Action's citations to each of the applied references is missing at least one element of each of Applicants' independent claims, Applicants respectfully submit that the claimed invention is not anticipated by the Office Action's citations to the applied references, as further discussed below.

For explanatory purposes, Applicants discuss herein one or more differences between the Office Action's citations to the applied references and the claimed invention with reference to one or more parts of the applied references. This discussion, however, is in no way meant to acquiesce in any characterization that one or more parts of the Office Action's citations to the applied references correspond to the claimed invention.

INDEPENDENT CLAIM 17 DISCUSSED WITH ALL APPLIED ART

Now is discussed the patentability of independent claim 17 presented herewith relative to the references applied to all the original claims. In view of the claim amendments presented herewith in connection with the remaining independent claims 1, 10, and 22 it is instructive to review the limitations of claim 17 discussed herein in connection with the applied references to review the patentability of independent claims 1, 10, and 22.

10

Applicants respectfully submit that the Office Action's citations to the applied references do not teach or suggest one or more elements of the claimed invention. A careful reading of the Office Action's citations to the applied references fails to teach or suggest, for example, the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

Steinmetz discloses (column 9, lines 19-53) configuration of ATMs:

In this described exemplary embodiment a servicer may manually input an authorization key or configuration certificate by typing information into a keypad of the ATM or otherwise providing such data through an input device on the ATM. Alternatively, the servicer may input an authorization key or a configuration certificate by reading the authorization key or configuration certificate with a portable medium reader such as a card reader, a floppy disk reader, a CD-ROM reader, or a scanner that is in operative connection with the ATM.

FIG. 3 shows a schematic view of an exemplary system 60 for authorizing the configuration of ATMs using an authorization key. Here the licensing authority 62 operates an authorization key generation[] application 64. The key generation application 64 includes an authorization algorithm 66 that is operative to produce a first authorization key responsive to[] information associated with an individual ATM 70. In the exemplary embodiment the first authorization key 72 is required to be input into a configuration software program 74 to enable the configuration software to configure the ATM 70. The exemplary configuration software 74 includes an authorization algorithm 76 that corresponds to the authorization algorithm 66 of the key generation application 64.

The authorization algorithm 76 is operative to produce a second authorization key responsive to information associated with the ATM 70. The configuration software 74 is operative to validate the input first authorization key by comparing it to the generated second authorization key. If the keys match, the configuration software 74 enables the configuration of the ATM 70 to proceed. If the keys do not match, the configuration of the ATM 70 is not allowed to proceed.

The servicer configuration of the ATM fails to disclose, *inter alia*, the activation of an option resident in memory of the ATM already in use as a remote stand-alone ATM for a remote user of the remote stand-alone ATM. Simply missing from the Office Action's citation to Steinmetz is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the

11

option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

So, the Office Action's citation to Steinmetz fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The shortcomings of the Office Action's citation to Steinmetz relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citation to Steinmetz with a citation to Silver. However, the Office Action's citation to Silver does not overcome the deficiency of the Office Action's citation to Steinmetz. Applicants respectfully submit that the proposed combination of the Office Action's citation to Steinmetz with the Office Action's citation to Silver fails to provide the required approach, assuming, *arguendo*, that the combination of the Office Action's citation to Steinmetz with the Office Action's citation to Silver is proper.

Silver discloses (paragraphs 7-8) an email device in serial with a telephone:

> Certain conventional systems (e.g., the Landel Telecom MailBug.TM. system) implement an email device that plugs into a household phone jack in serial with a telephone. A user of such a conventional system, therefore, does not need a personal computer to access email.
>
> Although a user of conventional systems plugs the device into a household phone jack, email reading and manipulation is performed "offline." In other words, using such a conventional system does not tie up a phone line for longer than the time required to download or upload email from a mail server. Thus additional phone lines or alternate Internet access mechanisms are not necessary for the system user to access email.

The email device in serial with the telephone allowing email reading and manipulation to be performed offline fails to disclose, *inter alia*, user request to self-enable a disabled option resident on the device. Simply missing from the Office Action's citation to Silver is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

So, the Office Action's citation to Silver fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

12

Durbin et al.   S/N: 09/683,561

The shortcomings of the Office Action's citation to Steinmetz relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citation to Steinmetz with a citation to Fenstemaker. However, the Office Action's citation to Fenstemaker does not overcome the deficiency of the Office Action's citation to Steinmetz. Applicants respectfully submit that the proposed combination of the Office Action's citation to Steinmetz with the Office Action's citation to Fenstemaker fails to provide the required approach, assuming, *arguendo*, that the combination of the Office Action's citation to Steinmetz with the Office Action's citation to Fenstemaker is proper.

Fenstemaker discloses (column 3, lines 26-51) a remote ultrasound vendor 410 transmitting a key to the ultrasound device 100:

> As mentioned above, in addition to or instead of locally receiving a key, the ultrasound device 100 can remotely receive a key, as illustrated in the flow chart of FIG. 4. First, a user requests a key from a remote source, such as an ultrasound device vendor (step 410). As described in more detail below, the request preferably comprises information identifying the feature to be enabled and the specific ultrasound device. Next, the key is generated by the remote source (step 420) and transmitted to the ultrasound device 100 via the key receiver 150, which can be, for example, a network link or modem (step 430). It is possible that the remote source can generate an incorrect key or that a correctly generated key can become corrupted by a noisy transmission. Accordingly, it is preferred that the feature control manager 130 verify the received key to ensure that it will enable the feature and acknowledge receipt to the remote source (step 440). If an acknowledgement is not received or if an error message is generated, the remote source can retransmit the key (step 450). It is important to note that although the method described above is preferred, other methods can be used. Regardless of the way in which the key is received, it is preferred that the received key be stored in the feature control database 160 for future or repeated use. Alternatively, the received key can be valid only for a single use.

The remote ultrasound vendor 410 transmitting the key to the ultrasound device 100 fails to disclose, *inter alia*, a centralized facility receiving from a user remote from a remote stand-alone ultrasound device an activation request for the option resident in the memory of the remote stand-alone ultrasound device. Simply missing from the Office Action's citation to Fenstemaker is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

13

Durbin et al. S/N: 09/683,561

So, the Office Action's citation to Fenstemaker fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The shortcomings of the Office Action's citation to Fenstemaker relative to certain elements of the claimed invention have been discussed above. The Office Action proposes a combination of the citation to Fenstemaker with a citation to Rive. However, the Office Action's citation to Rive does not overcome the deficiency of the Office Action's citation to Fenstemaker. Applicants respectfully submit that the proposed combination of the Office Action's citation to Fenstemaker with the Office Action's citation to Rive fails to provide the required approach, assuming, *arguendo*, that the combination of the Office Action's citation to Fenstemaker with the Office Action's citation to Rive is proper.

Rive discloses (column 5, lines 45-62, and column 18, lines 4-53) a computer system 50 and support computer 300 having remote access clients 304 installed thereon that enable the support computer 300 to take control of, or at least access, the computer system 50 for the purposes of modifying the configuration of the supported partition 54:

> FIG. 4 is a block diagram illustrating a computer system 50, configured according to an exemplary embodiment of the present invention. Specifically, the computer system 50 is shown to include a storage device, in an exemplary form of a hard drive 52, that is configured to include four partitions, each of which supports an operating environment. While the storage device is shown to be included within the computer system 50, the present invention requires that the storage device merely be accessible by the computer system 50, and could be external to the computer system 50 and, for example, accessed over a network. Alternatively, the storage device may be a hard drive 52 that is directly accessible by the computer system 50.
>
> The hard drive 52 is shown to include four partitions, namely a supported partition 54 from which a supported environment is implemented, an unsupported partition 56 from which an unsupported environment is implemented, a mirror partition 58 and an output partition 60.
>
> ...
>
> ...The steps illustrated in FIG. 12 will be described with reference to FIG. 13, which is a block diagram illustrating an exemplary embodiment of a remote computer 50 with a supported partition 54 having a specific configuration and a support computer 300 that is capable of remotely accessing the computer system 50 by a network, such as for example the Internet 302. To facilitate this remote access, the computer system 50 and the support computer 300 have remote access clients 304 installed thereon that enable the support computer 300 to take control of, or at least access, the computer system 50 for the purposes of modifying the configuration of the supported partition 54. In one exemplary embodiment, the remote access clients 304 may comprise NetMeeting.TM. client programs, developed by Microsoft Corporation. In an alternative embodiment, the remote access client 304 may comprise the pcAnywhere.TM. software, developed by Symantec Corporation.

14

Returning to FIG. 13, at step 280, the support computer 300 establishes remote control of, or at least access to, the computer system 50 via a network, for example the Internet 302. In this way, a support technician operating the support computer 300 is, at step 282, able remotely to access a registry editor 46 installed within the supported partition 54.

At step 284, the service technician, via the support computer 300 on the network 302, supplies a unique password to "unlock" the registry editor 46, and to disable the restrictions placed on the registry editor during an initial configuration of the supported partition 54. Having thus supplied the password, the service technician is, at step 286, able remotely to modify the registry 40 to enable launch, operation and execution of a pre-installed, but previously disabled or inactive, application program installed on the supported partition 54. As mentioned above, this may involve the removal of various restrictions implemented via the registry 40 and via the policy file 41. For example, the selected application may be designated as an "allowed" application, in which case the restrictions implemented by the registry 40 will no longer be applicable. Furthermore, icons via which a user may conveniently launch the relevant application may be restored to appropriate menus presented by the operating system 62 for the supported partition 54.

At step 288, the service technician may then restore restrictions imposed by the registry 40 applicable to the registry 40 itself, and to other applications that are not to be enabled or activated. At step 290, the service technician, via the support computer 300, then terminates the remote control of, or access to, the remote computer 50. The methodology then terminates at step 292.

The service technician via the support computer 300 supplying the unique password to unlock the registry editor 46 and disable the restrictions placed on the registry editor during an initial configuration of the supported partition 54 on the hard drive on the computer system 50 fails to disclose, *inter alia*, a centralized facility receiving from a user remote from a remote stand-alone device an activation request for the option resident in the memory of the remote stand-alone device. Simply missing from the Office Action's citation to Rive is any mention of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

So, the Office Action's citation to Rive fails to satisfy at least one of the limitations recited in Applicants' independent claim 17.

The Office Action includes the following Official Notice (paragraph 8, page 4, and paragraph 15, page 10):

15

However, the examiner takes Official Notice that receiving authorization codes through email is old and well established in the art of software activation as a method of quickly receiving the activation code without the need for paper, as evidenced by U.S. Patent 6,490,684 to Fenstemaker (col. 3, lines 1-4).

Fenstemaker (col. 3, lines 1-4) discloses:

The key can be in the form of alphanumeric symbols that can be supplied to the user in writing, over the phone, via email, or via facsimile, for example.

Applicants respectfully request a production of authority for the stated Official Notice that: 1) the receiving is old and well established in the art of software activation; and 2) the goal of quickly receiving the activation code without the need for paper.

Assuming, *arguendo*, authority can be produced for the Official Notice, it nevertheless on its face fail to disclose, *inter alia*, the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

In connection with a number of Applicants' dependent claims, the Office Action's citations to Mccown, Castagna, and Dutta, assuming, *arguendo*, they are correct, on their face fail to disclose, *inter alia*, the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

The Office Action's citations to Steinmetz, Silver, Fenstemaker, Rive, the Official Notice, Mccown, Castagna, and Dutta all fail to meet at least one of Applicants' claimed features. For example, there is no teaching or suggestion in the Office Action's citations to Steinmetz, Silver, Fenstemaker, Rive, the Official Notice, Mccown, Castagna, and Dutta of the computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote

16

Durbin et al. S/N: 09/683,561

stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device, as recited in Applicants' independent claim 17.

Furthermore, the Office Action does not allege that the art of record provides any teaching, suggestion, or incentive for modifying the citations to Steinmetz, Silver, Fenstemaker, Rive, the Official Notice, Mccown, Castagna, and Dutta to provide the claimed approach.

For the reasons presented above with reference to claim 17, claims 1, 10, 17, and 22 are believed neither anticipated nor obvious over the art of record. The corresponding dependent claims 2-9, 11-16, 18-21, and 23-26 are believed allowable for the same reasons as independent claims 1, 10, 17, and 22, as well as for their own additional characterizations.

Withdrawal of the §§ 102 and 103 rejections is therefore respectfully requested.
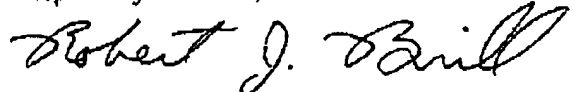
In addition, new claims 27-29 are believed allowable for the same reasons as the corresponding independent claims 1 and 22, as well as for their own additional characterizations.

Therefore, in light of at least the foregoing, Applicants respectfully believe that the present application is in condition for allowance. As a result, Applicants respectfully request timely issuance of a Notice of Allowance for claims 1-29.

Applicant hereby authorizes charging of deposit account no. 50-2402 for any additional fees associated with entering the aforementioned claims.

Applicant appreciates the Examiner's consideration of these Amendments and Remarks and cordially invites the Examiner to call the undersigned, should the Examiner consider any matters unresolved.

Respectfully submitted,

Robert J. Brill
Registration No. 36,760
Direct Dial 773-832-4070
rjb@zpspatents.com

Dated: November 17, 2005
Attorney Docket No.: GEMS8081.123

P.O. ADDRESS:
Ziolkowski Patent Solutions Group, SC
14135 North Cedarburg Road
Mequon, WI 53097-1416
262-376-5170

17